

REMARKS

The Examiner's communication dated December 27, 2004 has been received and carefully considered. In conformance with the applicable statutory requirements, this paper constitutes a complete reply and/or a bona fide attempt to advance the application to allowance. Claims 1, 12, 13 and 23 have been amended and detailed arguments in support of patentability are presented. Reexamination and/or reconsideration of the application as amended are respectfully requested.

Summary of the Office Action

Claim 1 was objected to for a minor informality.

Claims 23-27 were rejected under 35 U.S.C. § 112, second paragraph.

Claims 1, 12, 14-17 and 19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Chen (U.S. Patent Publication No. US-2004/0168379).

Claims 2-8, 18 and 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Murdaca (U.S. Patent No. 6,029,954).

Claims 9-11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen.

Claims 23-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Green (U.S. Patent No. 6,250,040).

Claims 23, 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over St. Gelais et al. (U.S. Design Patent No. 402,376).

Claims Objection(s)

Claim 1 has been carefully amended to resolve the claim objection(s) noted by the Examiner.

35 U.S.C. § 112

Claim 23 has been carefully amended to resolve the indefiniteness noted by the Examiner.

Claims Rejections in view of Chen Under § 102(e)/103(a)

Claims 1, 12, 14-17 and 19 were rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by Chen and claims 2-11, 13, 18 and 20-22 were rejected

under 35 U.S.C. § 103(a) as being unpatentable over Chen, alone or in combination with Murdaca.

Applicants have reviewed the filing and issue dates of Chen to determine its effective date. That review has led to a determination that the effective date of Chen is February 27, 2003. In view of the effective date of Chen, Applicants have executed and filed herewith a Declaration Under 37 C.F.R. 1.131 and supporting material (Exhibits A-F) to swear behind Chen. The Declaration sets forth possession of the invention of each of the pending claims at least prior to February 27, 2003, which is the effective date of Chen. Thus, possession antedates Chen.

Based on the attached Declaration and supporting material of Exhibits A-F, Applicants respectfully submit that Chen should be removed as a reference. Accordingly, Applicants request that the Examiner remove all rejections under 35 U.S.C. § 102(e) and/or 35 U.S.C. § 103(a) relying on Chen and allow claims 1-22 as included herein.

In addition, Applicants do not intend for the filing of the Declaration under § 1.131 to be construed as an admission that Chen discloses the same patentable invention of claims 1-22. Accordingly, Applicants reserve the right to persuasively argue that the presently claimed subject matter is patentably distinguishable from Chen.

Remaining Rejections Under § 103(a)

Claim 23 calls for a method of assembling a frame assembly including the step of inserting first ends of a plurality of pickets into a first plurality of spaced openings on a bottom frame member and inserting second ends of the plurality of pickets into a second, aligned plurality of spaced openings on a top frame member. The Examiner first asserts that Green teaches inserting a first end of a "picket 44" into a first spaced opening on a bottom frame member, inserting a second end of the picket into a second aligned opening on a top frame member 32, attaching a first side member 36 to the bottom frame and the top frame adjacent a first picket, and attaching a second side frame section 38 to the bottom frame member. The Examiner concedes that Green does not show a plurality of pickets as called for in claim 23. However, the Examiner asserts that it would have been obvious to one having ordinary skill in the art to add additional pickets, "since mere duplication of an element is considered routine in the art." Moreover, the Examiner asserts that additional pickets would increase the stability of the frame.

The Examiner also asserts that St. Gelais et al. teaches a plurality of pickets inserted into spaced openings on a bottom and top frame member, a first and second side frame member sections attached to bottom and top frame members, a second bottom frame member connected to the top frame member, third and fourth frame members attached to top frame members, and a screen installed between first and second frame sections. The Examiner concedes that St. Gelais et al. fails to recite the method steps of claim 23, but asserts that it would have been obvious to perform these steps to assemble the shown frame assembly.

Applicants respectfully disagree with the Examiner's obviousness conclusions concerning both Green and St. Gelais et al. The Examiner has provided no reference, or other evidence, to support his conclusion that it would have been obvious to one skilled in the art to modify Green or St. Gelais et al. by utilizing a plurality of pickets. Green is directed to a vinyl screen door, whereas claim 23 is directed to a frame assembly having a railing. St. Gelais et al. is directed to a panel for a gazebo and includes a lattice structure. Neither of the applied references even mention pickets. The Examiner has impermissibly concluded with hindsight that claim 23 is obvious in view of each of Green and St. Gelais et al., without any legitimate support on the record. Applicants respectfully request that, in accordance with the obligations imposed under MPEP § 2144.03, the Examiner provide a reference or other suitable evidence showing that it would have been obvious to one skilled in the art to modify Green or St. Gelais et al. by adding a plurality of pickets thereto.

Additionally, Applicants assert that the Examiner has failed to provide an appropriate motivation to modify either Green or St. Gelais et al. As the Examiner is aware, a *prima facie* case of obviousness is not established absent proper motivation. Simply because the vinyl screen door of Green could be modified to have a plurality of pickets, motivation to modify is not present. More is required to show motivation. Similarly, just because the lattice structure of St. Gelais et al. could be modified or substituted for by a plurality of pickets, motivation is not shown.

The MPEP is instructive on this point. Per MPEP § 2143.01, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ 2d 1991 (Fed. Cir. 1992)." In the present case,

Applicants have found no teachings, suggestions or motivation to modify Green or St. Gelais et al. as suggested by the Examiner anywhere in either reference. If the Examiner should contend otherwise, Applicants respectfully request that the Examiner explicitly cite the column and line numbers from Green and/or St. Gelais et al. where such teachings, suggestions or motivation may be found.

Moreover, according to MPEP § 2143.01, the "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness." Simply because the claimed elements are individually found in the prior art, it does not necessarily follow that it would be obvious to combine the elements from different prior art references. See MPEP § 2143.01 *citing Ex Parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). Consequently, absent a motivation to modify Green and/or St. Gelais et al., it is irrelevant that the elements and/or limitations may be individually or separately known in the prior art. Clearly, the Examiner is motivated to modify Green and St. Gelais et al. for no other reason than to arrive at the claimed invention (of claim 23). This is a classic example of impermissible hindsight.

Moreover, in calling for a plurality of pickets, claim 23 requires a structure unlike that disclosed in Green or St. Gelais et al. Specifically, the member 44 forming cross piece 40 in Green merely provides additional strength to a vinyl door 10 and is said to improve the appearance of the door 10 in which the cross piece 40 is used. The panel for a gazebo in St. Gelais merely shows a panel member having a lattice structure (no pickets are shown being received within aligned openings). In contrast, the pickets of claim 23 are received in aligned openings and, in one application, are provided to present a barrier along a raised floor structure for preventing a person from falling off the raised floor structure. Neither the single member 44 of Green, nor the lattice panel member of St. Gelais et al., would be suitable for such an application.

Accordingly, for at the reasons discussed in the preceding paragraphs, it is submitted that claim 23 and claims 24-27 dependent therefrom distinguish patentably over Green.

CONCLUSION

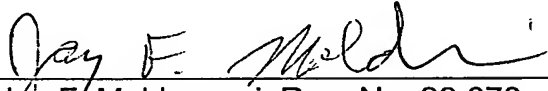
All formal and informal matters having been addressed, it is respectfully submitted that this application is in condition for allowance. Alternatively, if the Examiner is of the view that the application is not in clear condition for allowance, it is

requested that the Examiner telephone the undersigned for purposes of conducting a telephone interview to resolve any outstanding differences. Accordingly, an early notice of allowance is earnestly solicited.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP


March 28, 2005
Date


Jay F. Moldovanyi, Reg. No. 29,678
Erik J. Overberger, Reg. No. 48,556
1100 Superior Avenue
7th Floor
Cleveland, Ohio 44114-2579
(216) 861-5582

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